

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NIELS S. MOSSBECK and THOMAS J. WELLS

Appeal No. 2004-1317
Application No. 10/143,377

ON BRIEF

Before KIMLIN, WARREN and WALTZ, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12-15 and 23-25. Claims 1-11 and 16-22, the other claims remaining in the present application, have been allowed by the examiner.

Claim 12 is illustrative:

12. A method of packaging a plurality of spring units, each spring unit comprising a plurality of coil springs, each of said coil springs having a top turn and a bottom turn, said top turns of said coil springs defining a generally planar first surface and said bottom turns of said coil springs defining a generally planar second surface, said method comprising the steps of:

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providing a web of insulator material, said web of insulator material being adapted to separate said spring units from padding to be applied to said spring units,

locating said web of insulator material against one of said first and second surfaces, respectively, of said spring units;

applying securing elements to permanently secure said web of insulator material to said spring units; and

roll-packing said spring units and said web of insulator material such that said spring units are at least partially compressed and upon unrolling, said web of insulator material remains permanently connected to said spring units.

The examiner relies upon the following references as evidence of obviousness:

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|----------------------|-----------|---------------|
| Wunderlich | 2,114,008 | Apr. 12, 1938 |
| Kelly et al. (Kelly) | 5,438,718 | Aug. 8, 1995 |

Appellants' claimed invention is directed to a method of packaging a plurality of spring units which comprises, inter alia, providing a web of insulator material against one of the surfaces of the spring units, applying securing elements, such as adhesive tape or hog rings, for securing the insulator material to the spring units, and roll-packing the spring units into a state of at least partial compression. The roll-packed spring units are then available for shipping to a manufacturer of bedding or seating products.

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Appealed claims 12-15 and 23-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kelly in view of Wunderlich.

In accordance with the grouping of claims set forth at page 6 of appellants' Brief, claims 12, 23 and 25 stand or fall together. Appellants have presented separate arguments for claims 13, 14, 15 and 24.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejection for essentially those reasons expressed in the Answer.

Kelly, as explained by the examiner, discloses providing a web of insulator material to spring units for mattresses, etc., and permanently securing the insulator material with hog rings or other linking means that were known in the art (see column 3, lines 53-63). As appreciated by the examiner, Kelly does not disclose the claimed step of roll-packing the spring units into a state of partial compression. However, we fully concur with the examiner that Wunderlich evidences the obviousness of doing so.

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As acknowledged by appellants in their specification, Wunderlich discloses a spring roll-packing machine "in which a roll of disposable wrapping paper is fed along a table and into a wrapping mechanism whereat spring assemblies are placed upon the paper and fed into the machine by the paper movement" (page 3 of specification, last paragraph). Appellants also acknowledge the following at page 3 of the specification, first paragraph:

For instance, it is known in the art to pack spring units for use in making mattresses by winding disposable paper or re-usable hessian around a mandrel and feeding the spring units successively into the nip between the growing roll and the traveling web material. The spring units are compressed as they are drawn into the roll, and the result is that the roll-packed springs have a much reduced volume as compared to conventionally stacked spring units.

Appellants still further acknowledge that U.S. Patent No. 4,669,247 discloses "packing spring units into a roll with a web of disposable paper or reusable material" (page 3 of specification, last paragraph).

Accordingly, we find that it is abundantly clear that it was known in the art to perform the claimed roll-packing step on spring units, and we therefore find no error in the examiner's legal conclusion that "it would have been obvious to one of ordinary skill in the art at the time of the invention, to include the roll packing method of Wunderlich in the method of

manufacturing spring units for mattresses, as disclosed by Kelly et al., for reducing space, shipping, and storing problems (column 1, lines 9-12)" (page 4 of Answer, second paragraph). Moreover, from a somewhat different perspective, we find that it would have been obvious for one of ordinary skill in the art, based on the Kelly teaching, to secure insulator material on the spring units of the prior art before the admittedly known step of roll-packing.

As for the specific securing elements of separately argued claims 13, 14, 15 and 24, the examiner has taken official notice that the claimed taping, extruding, hog ringing and application of C-shaped securing elements are well-known securing techniques. Appellants have not refuted this finding of the examiner but only urge that Kelly does not expressly disclose such securing means. Appellants make no argument that the claimed securing means were unknown in the art, nor have appellants articulated why one of ordinary skill in the art would have found it nonobvious to employ the recited means for securing the insulator material to the spring units. In our view, the examiner has properly cited Kelly at column 1, lines 27-30 and column 3, lines 53-63 as evidence that it would have been obvious for one of ordinary skill in the art to select the particular securing elements

recited in claims 13, 14, 15 and 24. Indeed, we find appellants' argument regarding the hog ringing of claim 15 to be puzzling inasmuch as Kelly specifically discloses the use of hog rings (see column 3, line 58). We also note that appellants' specification attaches no criticality to the use of specific securing elements. We further note that appellants' specification teaches that "[t]his method of compressing the width of the spring unit 10 prior to the location of the web or webs of insulator material being applied may be used regardless of which type of securing element is used" (page 15, first paragraph, last sentence).

As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut the prima facie case of obviousness established by the examiner.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection. Claims 1-11 and 16-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Wunderlich. As acknowledged by appellants, the only substantive distinction between allowed claims 1-11 and 16-22, and rejected claims 12-15 and 23-25, is that the allowed claims provide for securing two webs of insulator material to the spring units. In the words of appellants:

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The only difference is that allowed independent claims 1 and 8 require permanently securing two webs of insulator material to multiple spring units with securing elements, whereas rejected independent claims 12, 23 and 25 require permanently securing only one web of insulator material to multiple spring units with securing elements. This difference between the application of one web of insulator material versus two webs of insulator material is not enough of a distinction to justify the rejection of independent claims 12, 23 and 25 [page 7 of Brief, second paragraph].

Manifestly, since we disagree with appellants with respect to the examiner's rejection of claims 12, 23 and 25 for the reasons set forth above, and appellants concede that there is not a significant distinction between securing two webs of insulator material and one web of insulator material, it follows that we find that the subject matter of claims 1-11 and 16-22 would have been obvious to one of ordinary skill in the art over the collective teachings of Kelly and Wunderlich.

In conclusion, based on the foregoing, the examiner's rejection of claims 12-15 and 23-25 under 35 U.S.C. § 103 is affirmed. A new ground of rejection under the provisions of 37 CFR § 1.196(b) of allowed claims 1-11 and 16-22 under 35 U.S.C. § 103(a) has been entered.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "[a]

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new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before

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the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED - 1.196(b)

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| EDWARD C. KIMLIN |) | |
| Administrative Patent Judge |) | |
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| CHARLES F. WARREN |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| THOMAS A. WALTZ |) | |
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